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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/764,617
Filing Date: January 26, 2004
Appellant(s): RHOADS ET AL.

Timothy N. Trop
(Reg. No. 28,994)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/23/2010 appealing from the Office action mailed 07/20/2009.

(1) Real Party in Interest

A statement identifying by name that real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,948,099

Tallam

9-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-15 and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Tallam (US PAT. 6,948,099).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Tallam discloses a method of organizing stored information comprising partitioning on a non-volatile, reprogrammable semiconductor memory (14, figure 1 and col. 2 lines 28-44) into a plurality of partitions (20 and 22, figure 2 and col. 2 line 66 through col. 3 line 15), each having a defined address (col. 2 line 45 through col. 3 line 15 and col. 4 lines 59-67), and storing the defined address for one partition in another partition (col. 2 line 66 through col. 4 line 6 and col. 6 lines 24-38).

Regarding claim 2, Tallam discloses the method further including storing information about the number of partitions (col. 4 line 59 through col. 5 line 39).

Regarding claims 3-5, Tallam discloses the method further including storing a boot loader (102, figure 5), a file system (106, figure 5), and a kernel for an operating system (104, figure 5) in one of said partition (col. 4 line 59 through col. 5 line 18).

Regarding claim 6, Tallam discloses the method further including storing information in association with the addresses about whether or not an integrity check needs to be done on the data stored at association address (col. 4 lines 26-50).

Regarding claims 7-9, Tallam discloses the method further including storing, in association with the address of a partition, information about the type of information stored in the partition, and storing information about whether or not the information stored at given partition is a boot loader, a kernel or a file system, and storing information about the load address for said

information in association with said address (col. 4 line 59 through col. 5 line 38, figure 5 and col. 8 lines 9-48).

Regarding claim 10, Tallam discloses a non-volatile, re-programmable semiconductor memory (14, figure 1 and col. 2 lines 36-44), comprising a plurality of addressable partitions, (20 and 22, figure 14), including a partition storing an operating system, i.e., primary operation system (22, figure 2), a storage location storing an address for one of said partitions in association with information about the information stored in said partition (20, figure 3, and col. 3 line 16 through col. 4 line 25).

Regarding claim 11, Tallam discloses a non-volatile, re-programmable semiconductor memory is a FLASH memory (col. 2 lines 36-44).

Regarding claims 12-15, Tallam discloses a non-volatile, re-programmable semiconductor memory wherein one of the said partitions stores a basic input/output system (32, figure 3), a file system (106, figure 5), a kernel for an operating system (104, figure 5), and a boot loader (102, figure 5).

Regarding claim 26, Tallam discloses a processor-based system (12, figure 6) comprising a processor (65, figure 6), a volatile memory (68, figure 6) coupled to said processor, and a re-programmable, non-volatile semiconductor memory (14 figure 6) coupled to said processor (col. 5 line 43 through col. 6 line 24), the semiconductor memory including a plurality of partitions (20 and 22, figure 2), one of said partitions storing an operating system (22, figure 2), and another of said partitions storing the address of the other partitions in association with information about what is stored in each of the partitions (figure 5 and col. 4 line 59 through col. 5 line 38).

Regarding claim 27, the limitations of the claim are rejected as the same reasons set forth in claim 11.

Regarding claims 28-30, the limitations of the claims are rejected as the same reasons set forth in claims 12-15.

(10) Response to Argument

Appellant's argument filed on 02/23/2010 have been fully considered but they are not persuasive.

A. Are claims 1-15 and 26-30 anticipated under 35 U.S.C. §102(e) by Tallam (US 6,948,099)?

In response to Appellant's Declaration under 37 C.F.R. § 1.132 (Attribution) filed 01/20/2009 to overcome the rejection of claims 1-15 and 26-30, the Declaration was insufficient to overcome the rejection because it failed to provide submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant (see MPEP 715.01 (c) II). In accordance with MPEP 715.01 (c) II, "When the unclaimed subject matter of a patent, application publication, or other publication is applicant's own invention, a rejection>, which is not a statutory bar, < on that patent or publication may be removed by submission of evidence establishing the fact that the patentee, applicant of the published application, or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent, application publication, or other publication is based. In re Mathews, 408 F.2d 1393, 161 USPQ

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276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).” As further reviewed the Declaration, the practitioner has provided allegations of facts, which is not considered as evidence. Thus, the Declaration failed to provide enough of evidences to prove which inventor(s) with their invented subject matter, or any of evidence to support the practitioner’s statements, for example, the Declaration failed to provide evidence of which material(s) as described in figure 5 of Tallam’s patent being invented by inventors Rhoads and Ketrenos. In addition, The Board of Appeal had affirmed the above rejection in responds to Appellant’s Appeal Brief filed on 05/11/2007 with Appeal docket number (2008-2317), as for the reasons as following “Firstly, the declaration is improper to show that the claimed subject matter is attributed to Appellants since they did not jointly file the present application with Tallam’s. Therefore, attribution is not germane to this case. Secondly, the declaration is insufficient to show that the invention was derived from Appellants since it fails to prove that Appellants invented the claimed subject matter. Particularly the submitted declaration merely provides a conclusory statement by appellants’ representative to suggest that the cited subject matter was invented by Appellants and not Tallam. The Board noted that such gratuitous statement, without any supporting evidence to show the actual descriptions or statements of the inventions that the representative received from each of the respective inventive entities before combining the inventions into one, is not persuasive. While the declarations and the exhibits are in the form of testimonial and corroborating evidence, arguments of counsel are not evidence. See, e.g., *Meitzner v. Mindick*, 549 F.2d 775,782 (CCPA 1977); *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).” (See pages 11-12 in the BPAI decision mailed on 11/21/2008). As a result,

the attribution or derivation points made in the Declaration are insufficient to overcome the section of 102(e) rejection. Therefore, the rejection of independent claim was sustained.

Appellants did not provide separate arguments with respect to art rejection of claims 1-15, and 26-30. Therefore, the claimed limitations are still being rejected by Tallam.

B. Conclusion

For the above reason, the Examiner respectfully submits that the referenced teaching anticipated the subject matter of any of the present claims. Therefore, affirming of all outstanding grounds of rejection and rejecting of all pending claims are respectfully solicited.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Zhuo H Li/

Examiner, Art Unit 2185

Conferees:

/Kevin L Ellis/
Supervisory Patent Examiner, Art Unit 2117

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